REMARKS

Formal Matters

The Applicant respectfully directs the Examiner's attention to claims 59-101 presented by Preliminary Amendment on November 14, 2003, just prior to mailing of the pending Office Action mailed on November 18, 2003. The Applicant regrets the Examiner was not able to examine the newly presented claims 59-101 and requests their entry for future and timely consideration.

Claims 1-6, 8-34 and 36-101 remain in this application. Claims 7 and 35 have been canceled. Claim 1 is amended. Support for the amendment to claim 1 is found throughout the specification, such as at page 4 line 38 to page 5, line 1.

No new matter is added by the amendments.

Priority

The specification is amended herein to claim priority to provisional application Ser. No. 60/143,360 filed on July 12, 1999. The instant application has an International filing date of July 11, 2000. This claim to priority does not require a petition since the International filing date is before November 29, 2000 and is perfected under 35 USC §119(e) by amendment to the specification to insert a specific reference to the prior application.

During the telephone conversation of April 13, 2004, the Examiner advised the Applicant that a petition to accept an unintentionally delayed claim for priority is not required.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph because, allegedly, the claim is vague and indefinite. The rejection is moot by cancellation of claim 7.

Rejection Under 35 U.S.C. § 102(a) "Meng"

Claims 1-6, 34-36, 39-45 and 49-58 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Meng et al (Gene Jan. 2000; 242:201-7). Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

The rejection is avoided by the perfection of the priority claim of the present invention to July 12, 1999. Because Meng has a publication date after the priority date of the present invention, Meng should be removed as a prior art reference. As a result, Meng does not anticipate Applicants claimed invention and the rejection should be withdrawn, which action is respectfully requested.

Rejection Under 35 U.S.C. § 102(b) "Chishima"

Claims 1-6 and 39-44 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Chishima et al (Cancer Research, May 15, 1997; 57:2042-47). Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

A reference anticipates a claim only if it discloses every element of the claim (Scripps Clinic & Res. Found. v. Genentech, inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991); Richardson v. Suzuki Motor Co., 868 f.2d 1226, 1236 (Fed. Cir. 1989). The absence from the reference of any claimed element negates anticipation (Kloster speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986).

In the instant rejection, Chishima is alleged to anticipate the rejected claims, with Kaufman (Kaufman et al (Nucleic Acids Res. (1991) 19(16):4485-4490) cited under MPEP § 2131.01 to provide information with regard to intrinsic properties of one or more of the elements of the rejected claims. The element found in Kaufman is the pED-mtx^{r} expression construct of Chishima.

Chishima teaches an expression vector comprising an amplifiable selectable gene (DHFR) and a GFP gene. The expression vector of Chishima does not teach or suggest an expression vector, i.e. a polynucleotide, that comprises a selected sequence encoding a desired

product, the selected sequence operably linked to either the amplifiable selectable gene or to the GFP gene, and to a promoter. The rejection relies on this element being taught by Kaufman, as an intrinsic property of the pED-mtx^r expression construct of Chishima. The CHO cells transformed with the expression vector of Chishima are merely selected for in MTX-containing medium by the presence of the DHFR gene and express GFP for detection and visualization. Chishima does not teach or suggest a selected sequence that encodes for a protein selected from the group consisting of cytokines, lymphokines, enzymes, antibodies, and receptors, a limitation found in claim 1 as amended herein.

The rejection is traversed due to this improper combination of the Chishima and Kaufman references. As a result, Chishima does not anticipate the claimed invention and the rejection should be withdrawn, which action is respectfully requested.

Rejection Under 35 U.S.C. § 103(a) "Meng"

Claim 46 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable as obvious over Meng et al (Gene Jan. 2000; 242:201-7). Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

The rejection is avoided by the perfection of the priority claim of the present invention to July 12, 1999. Because Meng has a publication date after the priority date of the present invention, Meng should be removed as a prior art reference. As a result, Meng does not render Applicants claimed invention obvious.

Rejection Under 35 U.S.C. § 103(a) "Meng", "Moir", "Lubinecki"

Claims 47-48 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable as obvious over Meng et al (Gene Jan. 2000; 242:201-7) further in view of Moir and Mao (Bioprocess Technol. (1990) 9:67-94) or Lubiniecki and Lupker (Biologicals (1994) 22(2):161-169). Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

The rejection is avoided by the perfection of the priority claim of the present invention to July 12, 1999. Because Meng has a publication date after the priority date of the present invention, Meng is removed as a prior art reference.

Moir teaches that proteins of interest can be targeted, or secreted, to the culture medium for production of those proteins from the recombinant cells of various host organisms. Lubinecki teaches that secreted or expressed proteins may be purified.

Moir and Lubinecki have not been combined as references or applied individually to assert unpatentability due to obviousness. Even so, Moir and Lubinecki do not disclose or suggest the method of producing a desired product from the polynucleotide of claim 1. Therefore, the cited references, in any combination, do not render Applicants claimed invention obvious.

Claim Objections

Claims 8-11, 13-33, 37-38 and 47-48 are objected to because they are depended on rejected base claims. If the rejected base claims are allowable, then the objected to claims should also be made allowable.

SUMMARY

Claims 1-6, 8-34, 36-58, and claims 59-101 presented in the Preliminary amendment of Nov. 14, 2003, are pending in the application. Claims 7 and 35 are cancelled without prejudice to later prosecution.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a two-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

GENENTECH, INC.

Date: April 15, 2004

By: _____

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